

Notice of Allowability

Application No.

09/762,363

Examiner

Jennine M. Brown

Applicant(s)

MORINI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE and IDS of 02/05/2004.
2. ☒ The allowed claim(s) is/are 1-38 and 41-43.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 02/05/2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 02/05/2004 has been entered.

Allowable Subject Matter

Claims 1-38 and 41-43 are allowed.

The following is an examiner's statement of reasons for allowance:

EP0362705 fails to teach or suggest the claimed succinate ester electron donors.

EP0360497 B1 fails to teach or suggest the claimed succinate ester electron donor claimed in claim 1, having radicals R_1 and R_2 equal to or different from one another and not hydrogen, the radicals R_3 to R_6 equal or different are hydrogen or carbon based group which are joined to the same carbon atom, can be linked together to form a cyclic structure, with the proviso that if R_3 to R_5 are hydrogen, R_6 must be a radical as claimed. The compounds listed on pages 4-5 do not contain radicals. The dependent claim lists specific embodiments of the succinate of claim 1 and none of these claimed succinates are found in the list of examples given in the reference. There

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would be no motivation to randomly choose those claimed in the instant application therefore would not be obvious variants of those in the reference.

Taiwanese Publication No. 70868 (partial translation) claims a catalyst component containing a titanium halide, electron donor compound not containing active hydrogen atoms supported on an anhydrous magnesium dihalide but does not specify the preferred embodiment of the electron donor compound in the primary claim. Claim 11 states that the electron donor compound is selected from a group consisting of alkyl, aryl and cycloaryl esters of maleic, fumaric, pivalic, methacrylic, succinic, malonic, phthalic and phosphoric acids. This list embodies a broad category of esters, none of which seemingly require a single radical, let alone more than one radical. A claimed compound may be unobvious even when it is encompassed by a disclosed generic formula. *In re Jones* 21 USPQ 2d 1941, 1943 (Fed. Cir. 1992). This is particularly true when a large number of compounds are encompassed and when the claimed compounds is not one of the preferred embodiments. *In re Baird* 29 USPQ2d 1550 (Fed. Cir. 1994); *In re Belle* 26 USPQ 1529 (Fed. Cir. 1993). The electron donors claimed in the instant application would not be obvious variants.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-F 8:00 AM - 6:00 PM; first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571) 272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb



Mark L. Bell
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